- 10 -

Armstrong *et al.*
Appl. No. 09/693,867

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 3-4, and 6-34 are pending in the application, with claims 1, 27, 28, 29, 30 and 31 being the independent claims. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Applicants' representative thanks Examiner Vu for the courtesies extended during the February 15, 2005 Examiner interview. Examiner Vu agreed that the arguments presented during the interview had merit and requested that Applicants file an Amendment and Reply to allow for further consideration of the outstanding rejections. In accordance with Examiner Vu's request, the preceding amendment and following remarks are presented for consideration. Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Description of the Invention

The present invention is directed to a method and system for providing rich media content over a computer network and more particularly to a highly reliable, transparent process for displaying high-quality online advertising imagery. As described in the invention, in the online advertising context, the process for providing rich media

content, such as video advertisements, must be "entirely passive and nearly instantaneous" to be most effective. Attempts to put video advertising onto Internet web pages have largely failed because of two fundamental technical characteristics of computer video—lack of standardization and very large file size—and their implications. Computer users are generally unwilling either to wait for large files to be transmitted or to take active steps to ensure a smooth replay, especially for the sake of viewing an advertisement. Advertisers are unwilling to spend money and effort on technologies that cannot reliably deliver uninterrupted imagery to a wide audience.

The present invention, on the other hand, provides a method for reliably delivering video ads without any interruption of the user's viewing experience. The present invention provides a highly reliable, entirely transparent process for displaying high-quality rich media content over a computer network. In accordance with one embodiment of the present invention, a server on a computer network automatically and transparently polls the software, hardware, or electronic appliance of an end user on the network, for the availability of software and/or hardware necessary for the local display of rich media content. Based on the client's response, the server automatically and transparently sends an appropriately formatted version of the rich media file to the client. Once the rich media file has been transferred in its entirety and stored, or cached, in the local memory of the client, the rich media content is displayed automatically, either immediately or according to a predefined schedule or display cue, in a designated display area. The user may then be able to manipulate the rich media content without affecting the other content or tasks that were being displayed prior to the display of the rich media content. The entire process of the present invention is transparent to the end user and requires no initiation or other action on the part of the end user. The process of the

- 12 -

Armstrong *et al.*
Appl. No. 09/693,867

present invention takes place in the background, while the user is performing other tasks or viewing other content than that which is being transferred.

Rejections under 35 U.S.C. § 103

Claims 1, 3-4, and 6-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,314,451 to Landsman *et al.* (the "Landsman patent") in view of U.S. Patent No. 6,035,339 to Agraharam *et al.* (the "Agraharam Patent"). The Examiner argues that the Landsman patent appears to disclose "a system and method for providing rich media contents to a user over a network comprising: a) determining media files and/or programs required to playback the media content delivered to user without a user request, i.e., advertisements, (b) transparently downloading into a local cache a version of the media content appropriate for the user to playback the content locally including a rich media file and an appropriate media player, [and] c) displaying/playing the media content, i.e. ads, to the user in a designated display area after the media content has been completely downloaded" (9/23/04 Reply at 3) (citations omitted). The Examiner argues that while the Landsman patent "does not explicitly teach the step of determining client ability to playback the rich media content," such determination "is well known in the art as disclosed by Agraharam," in particular "by examining [a] client profile," and therefore "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Landsman* with *Agraharam*'s teachings" (*Id.* at 3-4) (citations omitted). Applicants traverse this rejection.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-73, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). If the

examination at the initial stage does not produce a prima facie case of unpatentability, then without more evidence of unpatentability applicants are entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

The Landsman patent teaches a technique that is "transparent" to the user (Landsman patent, at title, at Abstract, at col. 10, line 5, etc.). In contrast to this, the Agraharam patent teaches a method intended for a user that "desires to download information" (Agraharam patent, at col. 1, line 11) and "requests" it (*Id.*, at col. 2, line 44). These techniques, and the motivations for their use, are explicitly opposite.

In its preferred embodiment, the Agraharam patent determines user terminal output requirements using "predetermined data" (Agraharam patent, at Abstract, at col. 1, line 40, etc.), which are contained in a user profile that is stored and maintained in a "database" (*Id.*, at Abstract, at col. 1, lines 42-45, etc.). Predetermination implies previous direct or indirect contact with the client machine, and maintenance of a database strongly suggests future contact. By contrast, the method taught by the Landsman patent involves no predetermination or database of user capabilities, relying instead on an agent that, upon contact with the client machine, is downloaded to it and issues requests based on its capabilities (Landsman patent, at col. 10, lines 27-29, at col. 11, lines 3-8, etc.).

- 14 -

Armstrong *et al.*
Appl. No. 09/693,867

This method is suitable for one-time contact; it neither requires previous contact nor suggests subsequent contact. By logical implication and by suggestion, the two methods are oppositely motivated.

The distinctions cited above between the Landsman and Agraharam patents are not trivial; rather, they are central to the respective inventions and to their motivations. Application of a determining process such as taught in the Agraharam patent, with its requirement for predetermined data and its use of a client profile database, would violate the teaching and motivation of the Landsman patent, with its single-contact capability and use of a downloaded client-side agent. A person of ordinary skill in the art therefore would not consider such a combination, and such a combination therefore cannot properly suggest the claimed invention.

Further, none of the cited references provide motivation or suggestion for a method for providing rich media content to a user, *without a request by the user for such content*, which *queries the user* as to the user's ability to playback the rich media content locally *without downloading executable code that persists on the user's storage media*. As discussed above, the Landsman patent relies on an agent that is downloaded to the client machine and issues requests based on its capabilities (Landsman patent, at col. 10, lines 27-29, at col. 11, lines 3-8, etc.). Similarly, in one embodiment of the Agraharam patent, "[i]f the network information delivery device has authority to access the end-user terminal, a program may be downloaded to the end-user terminal to determine the exact end-user terminal configuration." (Agraharam patent, at col. 1, lines 47-50; see also col. 3, ln. 64 - col. 4, ln. 22). Alternatively, where the network information delivery device does not have authority to access the end-user terminal, no query is made. Rather, the Agraharam patent relies on "predetermined data" (Agraharam patent, at Abstract, at col.

1, line 40, etc.), which are contained in a user profile that is stored and maintained in a "database" (*Id.*, at Abstract, at col. 1, lines 42-45, etc.). The Agraharam patent discloses that "[t]he user profile may be obtained when the end-user first subscribes to the network information delivery device." (Agraharam patent, col. 3, lines 31-32). A request by the end-user is required by this embodiment of the Agraharam patent.

In contrast to the methods disclosed in the Landsman and Agraharam patents, the present invention requires no request from the client side, e.g., by a user or by a downloaded agent. Instead, the present invention uses a server-side process, which polls the software, hardware, or electronic appliance of an end user concerning the availability of software and/or hardware necessary for the local display of rich media content, without a request by the user. To clarify this distinction, independent claims 1, 27, 28, 29 and 30 are amended above to recite that the determining step proceeds "<u>by querying the user</u>" without downloading executable code that persists on the user's storage media and without a request by the user. This is explicitly distinct from the approaches described in the Landsman and Agraharam patents. For at least these reasons, independent claims 1, 27, 28, 29 and 30 and claims 3-4 and 6-26, which depend from independent claim 1, are patentable. Applicants respectfully request that the Examiner reconsider the outstanding rejection and that it be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 31-34 have been rejected under 35 U.S.C. § 112 "because the specification, while being enabling for using a server process for determining a user's ability, does not reasonably provide enablement for determining user's ability <u>without requiring executable code that persists on the user's storage</u>." (9/23/04 Reply at 2)

- 16 -

Armstrong *et al.*
Appl. No. 09/693,867

To clarify, independent claim 31 is amended to recite that the determining step proceeds "by querying the user without downloading executable code that persists on the user's storage media." This amendment duplicates the language used in the other independent claims. For at least this reason, independent claim 31, and claims 32-34, which depend therefrom, are patentable, and Applicants respectfully request that the Examiner reconsider the outstanding rejection and that it be withdrawn.
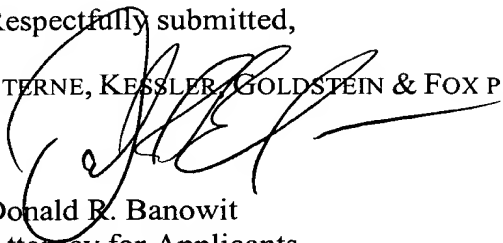
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully

requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Donald R. Banowit
Attorney for Applicants
Registration No. 42,289

Date: __February 23, 2005__

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
366441